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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/613,782

07/03/2003

Patrizio Mattei

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HOFFMANN-LA ROCHE INC.
PATENT LAW DEPARTMENT
340 KINGSLAND STREET
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EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,782

Applicant(s)

MATTEI ET AL.

Examiner

Tamthom N. Truong

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7,8 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,8,11,12 and 14-18 is/are rejected.
- 7) ☒ Claim(s) 5, 7, 10 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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FINAL ACTION

Applicant's amendment of 9-6-05 has been fully considered. The amended claim 1 has overcome the previous 102 and 103 rejections based on **Hess et. al.** (US'836) by not having "alkoxy" in the definition of R⁴. Thus, said rejection is withdrawn herein. However, the amended claim has not overcome the previous 103 rejection based on **Breu et. al.** (WO'488). Therefore, said rejection is maintained herein.

Claims 6 and 9 have been cancelled.

Claims 1-5, 7, 8 and 10-18 are pending.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-4, 8, 11, 12 and 14-18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over **Breu et. al.** (WO'488).

On page 11, Breu et. al. list several quinazoline compounds, two of which (e.g., compounds on lines 13 & 14) are analogous to compounds of the instant formula I with the following substituents:

- a. Ring A is pyrrolidinyl or piperidinyl;
- b. R^1 is $-N(R^5)(R^6)$ wherein R^5 and R^6 together with the N atom to which they are attached form a 6-membered heterocyclic ring such as *pyridine* or *pyrimidine*;
- c. R^2 is an alkyl group (or methyl);
- d. R^3 is hydrogen.

The disclosed compounds differ from the claimed compounds by not having the *pyridinyl* or *pyrimidinyl* bonded to the quinazolinyl ring via the ring N. However, the preferred embodiment on page 8 of WO'488 lists several rings represented by R^3 in which the *pyridinyl* and *pyrimidinyl* are not limited to a particular point of attachment. In other words, Breu et. al. seem to suggest an equivalent teaching for all points of attachment of those rings. Therefore, one would presume that the bonding of said rings to the quinazolinyl ring via N would still maintain the same biological activity.

Also, the generic teaching of WO'488 allows *pyrrolidinyl* or *piperidinyl* ring (represented by A^2) to be substituted with "alkoxy" (e.g., methoxy, ethoxy) as recited in the instant claims 11 and 12.

Like the claimed compounds, the disclosed compounds can treat obesity, and can also be given with *orlistat* simultaneously, separately or sequentially. Hence, the composition and method claims 14, 15 and 18 are also rendered obvious by Breu et. al.

The instant claims 16 and 17 recite a method of treating obesity using a combination of the compounds claimed herein and *orlistat* (60-720 mg per day). Although Breu does not

disclose the specific dosage of *orlistat*, said dosage would have been within the level of a skilled clinician to figure out since *orlistat* is a commercially available agent with an established dosage.

Thus, at the time that the invention was made, it would have been obvious to make and use some compounds of the instantly claimed formula I in view of the teaching of Breu et. al.

Note, the amended claim 1 has not overcome this rejection because it still recites the limitation of R⁵ and R⁶ forming a ring, which would corresponds to the heteroaryl represented by R³ in WO'488.

Claim Objections

2. Claims 5, 7, 10 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 5 and 7 recite subgenera of formula (I) wherein R¹ is OR⁴, and R⁴ is not an alkyl group (i.e., R¹ is not an alkoxy group), which is not taught by either Breu et. al. or Hess et. al. Claim 10 recites a subgenus of formula (I) wherein R¹ is -NR⁵R⁶ with R⁵ and R⁶ as independent substituents, which is not taught or fairly suggested by Breu et. al. or Hess et. al. Similarly, claim 13 recites specific compounds of R¹ as OR⁴ or NR⁵R⁶ wherein R⁴-R⁶ are all independent substituents. Said compounds are not taught or fairly suggested by Breu et. al. or Hess et. al.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

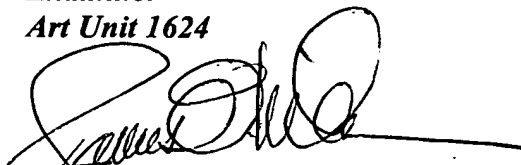
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11-28-05


Tamthom N. Truong
Examiner
Art Unit 1624


JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
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